Supreme Court, U.S.
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No.

IN THE

Supreme Court of the United States

DOUGLAS FAULKNER, ET. AL, PETITIONERS

v.

NATIONAL GEOGRAPHIC SOCIETY, ET. AL

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Whether the preservation of context of works contributed to a collective work is all that is needed to permit its publishers to reproduce them in new anthologies as a privileged "revision" of each and every included collective work, without regard to the impact of added materials upon the character of the new digital product, under 17 U.S.C. § 201(c) and *New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001).

(A.) Did this Court's *Tasini* decision establish only one permissible analytical framework for deciding the dichotomous inquiry of whether a particular work is a privileged "revision" of a previous work under 17 U.S.C. § 201(c), or an unprivileged "new" or "other" work, and does its analysis so substantially depart from the *Greenberg* analysis (*Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001) (corrected opinion), *cert. denied*, 534 U.S. 951 (2001)) that it represents an intervening change in law?

(B.) Does 17 U.S.C. § 201(c) have any application to situations where contributing authors and publishers entered into written contracts which did not include any republication rights, and was it incumbent upon contributing authors to expressly limit publication rights licenses or upon collective works publishers to expressly secure the publication rights licenses they wanted?

PARTIES TO THE PROCEEDINGS

Douglas Faulkner; Sally Faulkner; David Hiser; David G. Allen as Successor in Interest to Arthur Allen; Richard Conniff; Jon Krakauer; John Knoebber; Elizabeth Royte; Joe Baraban; Pamela Wilson Sartorelli; Doranne Jacobson; and Jerome Jacobson, Petitioners

National Geographic Society, National Geographic Enterprises, Inc., National Geographic Interactive, and National Geographic Holdings, Inc. d/b/a National Geographic Interactive d/b/a National Geographic Enterprises, Inc., Eastman Kodak Company, and Dataware Technologies Inc.; Louis Psihoyos; Matrix International, Inc., as agent for Roger Hutchings and Rick Rickman; David Robert Austin; and Fred Ward, Respondents.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

PARTIES TO THE PROCEEDINGS ii

TABLE OF AUTHORITIES v

OPINIONS BELOW 1

JURISDICTION 1

STATUTES INVOLVED 1

STATEMENT OF THE CASE 2

REASONS FOR GRANTING THE PETITION 10

CONCLUSION 29

APPENDIX

Appendix A *Faulkner v. National Geographic Enterprises Inc.*, 409 F.3d 26 (2d Cir. 2005) 1a

Appendix B *Faulkner v. National Geographic*, 296 F.Supp.2d 488 (S.D.N.Y. Dec. 23, 2003) 31a

Appendix C *Faulkner v. National Geographic Society*, 294 F.Supp.2d 523 (S.D.N.Y. Dec. 11, 2003) 42a

Appendix D *Faulkner v. National Geographic*, 220 F.Supp.2d 237 (S.D.N.Y. Sept. 4, 2002) 99a

Appendix E *Faulkner v. National Geographic*, 211 F.Supp.2d 450 (S.D.N.Y. July 13, 2002) 107a

Appendix F Denial of Rehearing (July 21, 2005).....163a

Appendix F 17 U.S.C. § 101 and 17 U.S.C. § 103(b).....164a

17 U.S.C. § 201(c) 165a

TABLE AUTHORITIES

Cases

BACH V. PATAKI, 408 F.3D 75 (2D CIR. 2005) 22

COMMUNITY FOR CREATIVE NON-VIOLENCE V. REID, 490 U.S. 730, 749 (1989) 18

FAULKNER V. NATIONAL GEOGRAPHIC ENTERPRISES INC., 409 F.3D 26 (2D CIR. 2005) 1, 6

FAULKNER V. NATIONAL GEOGRAPHIC, 211 F.SUPP.2D 450 (JULY 13, 2002) 1

FAULKNER V. NATIONAL GEOGRAPHIC, 220 F.SUPP.2D 237 (SEPT. 4, 2002) 1

FAULKNER V. NATIONAL GEOGRAPHIC, 294 F.SUPP.2D 523 (DEC. 11, 2003) 1

FAULKNER V. NATIONAL GEOGRAPHIC, 296 F.SUPP.2D 488 (DEC. 23, 2003) 1

FEIST PUBLICATIONS, INC. V. RURAL TELEPHONE SERVICE COMPANY, 499 U.S. 340 (1991) 8

FOX FILM CORPORATION V. DOYAL, 286 U.S. 123, 127 (1932) 5

GERSHWIN PUB. CORP. V. COLUMBIA ARTISTS MANAGEMENT, INC., 443 F.2D 1159, 1162 (C.A.2 1971) 27, 28

GREENBERG V. NATIONAL GEOGRAPHIC SOCIETY, 244 F.3D 1267 (11TH CIR. 2001), (CORRECTED OPINION), CERT.

DENIED, 534 U.S. 951 (2001) ..... PASSIM

HARPER & ROW, PUBLISHERS, INC. v. NATION ENTERPRISES, 471 U.S. 539, 558, 105 S.CT. 2218, 85 L.ED.2D 588 (1985) 26

KALEM CO. v. HARPER BROTHERS, 222 U.S. 55, 62- 63, 32 S.CT. 20, 56 L.ED. 92 (1911) 27

METRO-GOLDWYN-MAYER v. GROKSTER, ___ U.S. ___, 125 S.CT. 2764, 2794 (2005) 15, 27

NEW YORK TIMES CO., INC. v. TASINI, 533 U.S. 483 (2001) ..... PASSIM

SONY CORP. v. UNIVERSAL CITY STUDIOS, 464 U.S., AT 434 27

SONY v. UNIVERSAL CITY STUDIOS, 464 U.S. 417, 429 (1984) 28

STATE OIL CO. v. KHAN, 522 U.S. 3 (1997) 22

STEWART v. ABEND, 495 U.S. 207, 223 (1990) 4, 14, 26

TASINI v. NEW YORK TIMES, 206 F.3D 161, 170, (2D CIR. 2000, AS AMENDED) 25

UNITED STATES v. DIEBOLD, 369 U.S. 654, 655 (1962) 24

Statutes

17 U.S.C. § 101 1

17 U.S.C. § 103(b) 3, 9

17 U.S.C. § 201(c) ..... passim

28 U.S.C. § 1254(1) 1

Constitutional Provisions

U.S. Const. art. I, § 8, cl. 8 18

OPINIONS BELOW

The opinion of the Court of Appeals is reported at *Faulkner v. National Geographic Enterprises Inc.*, 409 F.3d 26 (2d Cir. 2005), and is reprinted in Appendix A to the Petition ("Pet. App.") at Pet. App. 1a-31a. A motion for en banc rehearing was filed on March 18, 2005 by Plaintiffs-Appellants Louis Psihoyos, Rick Rickman, David Robert Austen and Matrix International Incorporated, which was denied on July 21, 2005, reprinted in Pet. App. F at 163a-164a.

The District Court's opinions are reported in *Faulkner v. National Geographic*, 296 F.Supp.2d 488 (Dec. 23, 2003), reprinted at Pet. App. B at 32a-42a; *Faulkner v. National Geographic*, 294 F.Supp.2d 523 (Dec. 11, 2003), reprinted in Pet. App. C at 43a-99a; *Faulkner v. National Geographic*, 220 F.Supp.2d 237 (Sept. 4, 2002), reprinted in Pet. App. D at 100a-107a; and *Faulkner v. National Geographic*, 211 F.Supp.2d 450 (July 13, 2002), reprinted in Pet. App. E at 108a-162a.

JURISDICTION

The Court of Appeals entered its decision on March 4, 2005. The motion for an en banc rehearing was denied on July 21, 2005. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTES INVOLVED

This case involves provisions of the Copyright Act, 17 U.S.C. § 101, *et seq.*, specifically §§ 101, 103(b) and 201(c). The pertinent provisions are reproduced in Pet. App. G at 165a-166a.

STATEMENT OF THE CASE

This case concerns whether a publisher of collective works is privileged under 17 U.S.C. § 201(c) to exploit and profit from the reproduction and distribution of copyrighted contributions to those collective works in dozens of new products, without consent of or compensation to the authors of the contributions, so long as the context of the contribution is maintained.

Petitioners are photographers and text authors whose works[1] were published in *National Geographic* magazine in paper form ("NGM"), which has been published for over one hundred years by the National Geographic Society ("NGS").

This petition should be granted because the Second Circuit's judgment conflicts with this Court's teachings in *New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001), and the judgment of the Eleventh Circuit in *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001), (corrected opinion), *cert. denied*, 534 U.S. 951 (2001), which involved the same defendants and products.

In *Tasini*, this Court taught that a publisher could not reproduce or distribute copies of authors' contributions within a new collective work, and that reuse of a contribution under the 17 U.S.C. § 201(c) requires maintenance of the context of the work in the original collective work. In analyzing when a proposed work is a "revision" or a "new" work, this Court found that the whole of a digital database of numerous periodical issues in the *Tasini* case is "not recognizable as a new version of its every small part" and "simply cannot bear characterization as a 'revision' of any one periodical edition." *Tasini*, 533 U.S. at 500 and 501 n. 9.

The Second Circuit embraced the requirement of preservation of context but wholly failed to appreciate the

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[1] Works consist of photographic images ("images") and text articles ("texts").

requirement that the proposed work also be a version of the original collective work in which the at-issue work appeared rather than a new and different work.

In its analysis of the CNG, the Eleventh Circuit evaluated the products at issue in both Circuits and the various new features and arrangements of the underlying works within the new collective works and found that the CNG was not a "revision" of any of the print magazines, notwithstanding the in-context inclusion of the magazines, and that it was a massive new digital anthology. The Second Circuit ignored the volume and nature of additional new material and took the position that the in-context reproduction of the print magazines rendered the CNG still a "revision" of the included print magazines because the user would perceive the new electronic compilations as nothing more than replicas of the former collective works, i.e., the NGMs. The Second Circuit's decision is egregiously erroneous; it is in conflict with this Court's teachings in *Tasini* and it frustrates the legislative purposes of 17 U.S.C. § 201(c) and the Copyright Act.

Respondents have infringed Petitioners' copyrights by incorporating their images and texts into new digital anthologies without seeking permission from, or paying compensation to, the copyright owners of the contributions. Respondents have facilitated and encouraged wholesale secondary copying by end-users who were never granted a license by the copyright owners. Respondents never paid for the electronic uses and the written agreements between the parties did not provide for anything other than print on paper usage. Respondents have collected in excess of $100 million from these infringing acts.

The Second Circuit's refusal to hold Respondents accountable is a complete departure from the established principles of copyright ownership and liability. The Copyright Act addresses the question of ownership of the underlying works in a compilation in 17 U.S.C. § 103(b) [Pet. App. at 165a],

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material. (emphasis added).

This Court explained the impact of § 103(b):

> So long as the pre-existing work remains out of the public domain, its use is infringing if one who employs the work does not have a valid license or assignment for use of the pre-existing work.... It is irrelevant whether the pre-existing work is inseparably intertwined with the derivative work. *Stewart v. Abend*, 495 U.S. 207, 223 (1990) (citations omitted).

This Court held the New York Times Company, Inc. liable in *Tasini* for infringing uses of works contributed to collective works because the context of the works was not maintained and because they were used in "new" works. 533 U.S. 483, 488 (2001),

> The publishers are not sheltered by § 201(c), we conclude, because the databases reproduce and distribute articles standing alone and not in context, not "as part of that particular collective work" to which the author contributed, "as part of ... any revision" thereof, or "as part of ... any later collective work in the same series.

The Second Circuit read *Tasini* as permitting reuse of contributed works to a collective work in new products so